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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/846,466	07/29/2010	David Cooper	13665/AZ	2026
23389 7590 07/23/2012 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER PHUONG, DAI				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
07/23/2012		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

12/846,466

Applicant(s)

COOPER, DAVID

Examiner

DAI A. PHUONG

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/09/12.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Argument

1. Applicant's arguments filed 05/09/12 have been fully considered but they are not persuasive.

Claims 1-7 are pending.

Applicant, on page 2 of the remark, argues that the cited references fail to teach, suggest or render obvious the limitation of the plurality of available networks are determined by the current active mobile communication network by scanning an area for all available networks within the area, as recited, *inter alia*, in each of the limitations. However, the Examiner respectfully disagrees.

Firstly, according to dictionary.com, the term “scan” is to examine the particulars.

Secondly, Desantis et al. disclose that the current base station sends cell adjacency information to the mobile, and the cell adjacency information is used to identify the cells adjacent to the cell in which the mobile is currently located, and the potential handover candidates will correspond to beacons generated by these adjacent cells (see at least col. 2, lines 35-45). More importantly, the adjacency information may be obtained by each of the base stations listening to transmissions from other base stations, with a measure (examine) such as average signal strength used to determine the adjacent cells for a given cell (see col. 6, lines 1-12 and lines 55-65). In other words, the current base station listen, measures/examines/scans signal strength of each adjacent cells and transmits the adjacency information to the mobile. For the reasons above, the Examiner contends that the cited references show all limitations in the claims.

Applicant, on page 3 of the remark, argues that DeSantis and Lynch fail to teach a "means for providing a second message specifying deletion of network identifiers in the stored first list in the user equipment while a call is in progress," as recited, *inter alia*, in independent claim 2 and "a transmitter for transmitting a second message specifying deletion of network identifiers in the stored first list in the user equipment while a call is in progress," as recited, *inter alia*, in claim 5. Notably, the Official Action asserts that the "zero" message is the claimed "second message". However, *pro arguendo*, using this interpretation, the references still do not teach or suggest the claimed invention. The "zero" message is not transmitted while the call subject to handover is in progress. Additionally, the zero messages refer to the preferred list of SIDs, which is not equivalent to the first list. Therefore, the "zero" message is not the claimed second message. In response to this argument, during the interview, the Examiner asserted that the Applicant is arguing the references separately. Applicant respectfully disagrees. Applicant is reading the references as a whole and not picking and choosing features of the references. The zero messages in Lynch is for a specific list, which is not the same list as the claimed invention. However, the Examiner respectfully disagrees.

Firstly, according to Newton's Telecom Dictionary, edition 18th, the term "call" is to set up a connection between two stations. Therefore, the Examiner interprets "call" as a connection between the system and the mobile unit.

Secondly, Lynch et al. disclose that the system sends a preferred list to the mobile subscriber unit when it is power or periodically thereafter (see at least col. 8, lines 16-22. The Examiner may interprets this is a first message). Furthermore, the system sends another message

and set the most significant bit to be "zero" that indicates the mobile unit to delete the preferred list stored in the memory of the mobile unit (see col. 16, lines 21-40. The Examiner may interpret the another message is a second message). Again, the mobile unit receives the first message and second message from the system while connecting/calling with the system. For the reasons above, the Examiner contends that the cited references show all limitations in the claim.

Thirdly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Fourthly, In response to applicant's argument that the zero messages in Lynch is for a specific list, which is not the same list as the claimed invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Fifthly, In response to applicant's argument that the zero messages in Lynch is for a specific list, which is not the same list as the claimed invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant, on page 4 of the remark, argues that the measurement is not of the signal level of a signal received from the mobile, but rather a signal level received by the mobile from other

base stations. Further, Satarasinghe does not teach that the transmission of the first list is based upon the determined signal level. The references describes adding a pilot signal to an active pilot list, however, this is not the same as the claimed first list. Therefore, Satarasinghe fails to teach:

- 1) transmitting the claimed first list,
- 2) determining a signal level of a signal received from the user equipment, and
- 3) the transmission of the first list is based upon the determined signal level.

Pro arguendo, assuming a motivation to combine, the cited combination would be deficient. Therefore, claim 7 is patentable over the cited references. However, the Examiner respectfully disagrees.

Firstly, the claim recites "a signal level of signal received from the user equipment". In this case, the Examiner may interpret the signal level is received by the user equipment.

Secondly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims [28, 36 and 38] of co-pending Application No. 09/589,217 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims cover the same subject matter.

Both independent claims' features of the instant application and the co-pending application can be compared as:

Claim 1 of Instant Application	Claims 28, 36 and 38 of Co-pending Application No. 09/589,217
Claim 1. User equipment for a mobile communication network comprising:	Claim 28. (Currently Amended) A method for user equipment for a mobile communication system comprising:
means for receiving a first message from a current active mobile communication network while a call is in progress, said first message including a first list of a plurality of network identifiers	receiving a message on said user equipment including a first list including a plurality of network identifiers corresponding to a plurality of available networks available for a potential handover, the plurality of

corresponding to a plurality of available networks for a potential handover, the plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area;	available networks are determined by the current active communication network by scanning an area for all available networks within the area, said receiving from a current active communication network while a call is in progress (see claim 28); and
means for comparing the first list with a second list which includes at least a network identifier and is stored in the user equipment;	selecting one network of the plurality of available networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment (see claim 28),
means for selecting one network of the plurality of available networks to which the user equipment hands over based on the comparing the first list and the second list;	selecting one network of the plurality of available networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment (see claim 28),
means for storing the first list; and	storing said first list in said user equipment

	(see claim 36)
means for receiving a second message specifying deletion of network identifiers in the stored first list wherein said current active communication network signals the plurality of network identifiers corresponding to the plurality of available networks for the potential handover, and said receiving of said first and second messages occur without said user equipment searching said mobile communication network.	receiving, by the user equipment, a second message including at least one network identifier corresponding to a network that is to be deleted from the first list (see claim 38); wherein said current active communication network signals one or more of the plurality of network identifiers corresponding to the plurality of available networks for the potential handover, and said receiving of said message occurs without said user equipment searching any communication network (see claim 28)

Claims 2-7 of the instant application and claims [28, 36 and 38] of the co-pending application can be compared as same as above.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSantis et al. (U.S. 6728540) in view of Lynch (US 5,761,618; cited by applicant).

NOTE: according to dictionary.com, the term “scan” is to examine the particulars.

Regarding claim 1, DeSantis et al. disclose user equipment for a mobile communication network comprising:

means for receiving a first message from a current active mobile communication network while a call is in progress, said first message including a first list of a plurality of network identifiers corresponding to a plurality of available networks for a potential handover, the plurality of available networks are determined by the current active mobile communication network by scanning an area for all available networks within the area (col. 6, line 34 to col. 7, line 2. The base station receives the handover assistance request and examines the stored adjacency matrix to determine the cell or cells adjacent to the current cell. The base station in step 226 then determines whether the mobile will be able to detect beacons from each of the adjacent cells. If one or more of the adjacent cells are blocked such that the mobile is unable to detect beacons from these cells, the base station in step 228 transmits observable beacons for these blocked cells. The base station in step 230 then sends handover candidate information regarding the beacons for the cells adjacent to the mobile. This handover candidate information may include, for example, frequency and time slot for each of the adjacent cell beacons available to the mobile, and is used by the mobile to limit its search for a handover destination);

means for storing the first list (col. 6, line 34 to col. 7, line 2. The base station in step 230 then sends handover candidate information regarding the beacons for the cells adjacent to the mobile. This handover

candidate information may include, for example, frequency and time slot for each of the adjacent cell beacons available to the mobile, and is used by the mobile to limit its search for a handover destination);

wherein said current active communication network signals the plurality of network identifiers corresponding to the plurality of available networks for the potential handover area (col. 6, line 34 to col. 7, line 2. The base station in step 226 then determines whether the mobile will be able to detect beacons from each of the adjacent cells. If one or more of the adjacent cells are blocked such that the mobile is unable to detect beacons from these cells, the base station in step 228 transmits observable beacons for these blocked cells), and

said receiving of said first message occurs without said user equipment searching said mobile communication network for available networks (col. 6, line 34 to col. 7, line 2. The base station receives the handover assistance request and examines the stored adjacency matrix to determine the cell or cells adjacent to the current cell. It should be noted that the base station searches and transmits the available networks to the mobile unit without the mobile unit searching).

However, DeSantis et al. do not disclose means for comparing the first list with a second list which includes at least a network identifier and is stored in the user equipment; means for selecting one network of the plurality of available networks to which the user equipment hands over based on the comparing the first list and the second list; and means for receiving a second message specifying deletion of network identifiers in the stored first list.

In the same field of endeavor, Lynch discloses means for comparing (“compared”, col. 12, lines 1-5) the first list with a second list which includes at least a network identifier

("received SIDs"; col. 12, lines 1-5) and is stored in the user equipment ("selected and stored"; col. 12, lines 1-5);

means for selecting one network of the plurality of available networks to which the user equipment hands over based on the comparing the first list and the second list ("selected and stored"; col. 12, lines 1-5); and

means for receiving a second message specifying deletion of network identifiers in the stored first list ("set to "zero" for a deletion from the SID list stored in the mobile subscriber unit" see col. 16, lines 21-46); and

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of DeSantis et al. as taught by Lynch for purpose of preventing to interrupt the call and a high roaming cost.

Claims 2-6 are similar to claim 1. Therefore, the claims are rejected with the same rationale as analyzed in claim 1.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeSantis et al. (U.S. 6728540) in view of Lynch (US 5,761,618; cited by applicant) and further in view of Satarasinghe (U.S. 6026301).

For claim 7, the combination of DeSantis et al. and Lynch do not disclose a mobile communication network of claim 2, further comprising means for determining a signal level of a signal received from the user equipment, and wherein the first list is provided by the means for providing a first message based upon the determined signal level.

In the same field of endeavor, Satarasinghe discloses a mobile communication network of claim 2, further comprising means for determining a signal level of a signal received from the user equipment, and wherein the first list is provided by the means for providing a first message based upon the determined signal level (col. 3, lines 39-67. To determine when to initiate and execute handoff, the CDMA cell site repeatedly measures the RTD value of the mobile unit. As the mobile unit moves around the CDMA cell, it measures pilot signals from one or more cell sites operating on the same frequency used by the CDMA cell site and communicates these measured pilot signals to the CDMA cell site. The CDMA cell site then commands the mobile unit to add the pilot signals to an active pilot list).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of DeSantis et al. as taught by Satarasinghe for purpose of preventing to interrupt the call and a high roaming cost.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAI A PHUONG/
Primary Examiner, Art Unit 2617
Date: 07/18/12

Notice of References Cited

Application/Control No.

12/846,466

Applicant(s)/Patent Under
Reexamination
COOPER, DAVID

Examiner

DAI A. PHUONG

Art Unit

2617

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,728,540	04-2004	DeSantis et al.	455/437
*	B	US-6,026,301	02-2000	Satarasinghe, Prasanna Jayaraj	455/436
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			


FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS


*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<i>Index of Claims</i> 	Application/Control No. 12846466	Applicant(s)/Patent Under Reexamination COOPER, DAVID
	Examiner DAI PHUONG	Art Unit 2617

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

<input type="checkbox"/> Claims renumbered in the same order as presented by applicant				<input type="checkbox"/> CPA				<input type="checkbox"/> T.D.				<input type="checkbox"/> R.1.47			
CLAIM		DATE													
Final	Original	11/05/2011	07/18/2012												
	1	✓	✓												
	2	✓	✓												
	3	✓	✓												
	4	✓	✓												
	5	✓	✓												
	6	✓	✓												
	7	✓	✓												

Search Notes 	Application/Control No. 12846466	Applicant(s)/Patent Under Reexamination COOPER, DAVID
	Examiner HUY PHAN	Art Unit 2617

SEARCHED

Class	Subclass	Date	Examiner
455	436,437,438,439,442,443,444,432.1,435.2	11/01/06	HP
370	331,332,333,328	11/01/06	HP
	East Search Updated	07/15/2011	ad
	East search updated	11/05/11	ad
	East search updated	7/18/12	ad

SEARCH NOTES

Search Notes	Date	Examiner
Consulted with: Jean Gelin, Lester Kincaid	04/17/07	HP
John Peng, Matthew Anderson	06/20/08	HP
EAST search updated	06/20/08	HP
Inventor search	06/20/08	HP
EAST search updated	01/21/09	HP
Inventor search updated	01/21/09	HP
Consulted with Wellington Chin (101 issue), Rafael P.G. (DPR issue)	01/21/09	HP
EAST search updated	6/15/09	HP
Inventor search updated	6/15/09	HP
EAST search updated	10/22/2009	HP
Inventor search updated	10/22/2009	HP
EAST search updated	3/26/2010	HP
Inventor search updated	3/26/2010	HP
All search updated	2/10/2011	HP
Inventor search updated	07/15/2011	ad
Inventor search updated	11/05/11	ad
Inventor search updated	7/18/12	ad

INTERFERENCE SEARCH

Class	Subclass	Date	Examiner
455	450,517,422.1	01/21/09	HP

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